

REMARKS

In the Office Action mailed March 22, 2007, the Examiner rejected claim 7 under 35 U.S.C. 102(e) as being anticipated by Peterson et al., U.S. Patent No. 5,933,812. Applicant notes that this patent has never issued from the PTO because U.S. Patent No. 5,933,812 issued to Meyer et al. as noted by the Examiner on page 3 of the Office Action. In the portion of the Office Action detailing the Examiner's analysis of the ground of rejection, the Examiner refers to Peterson and cites to paragraph number 129 on page 12. This paragraph numbers seem to comport with paragraph 129 on page 12 of U.S. Publ. No. 2003/0170033 for Peterson, which was noted by the Examiner in the Notice of References Cited that accompanied the Office Action. Therefore, Applicant believes the Examiner based the section 102(e) ground of rejection on Peterson, U.S. Publ. No. 2003/0170033 and the remarks below are made in light of that belief.

In the Office Action, the Examiner also rejected claims 1-6 and 8-18 under 35 U.S.C. 103(a) "as being unpatentable over Meyer et al. U.S. Patent No. 5,933,812 in view of Baker et al. U.S. Patent No. 7,019,492." While these patents did issue from the PTO, the Examiner never refers to Meyer et al., but rather cites to Peterson and paragraph number 129 on page 12 that seems to comport with U.S. Publ. 2003/0170033. The Examiner does refer to teachings within Baker in the section detailing the action based on the section 103 ground of rejection. Therefore, Applicant has concluded that the Examiner rejected claims 1-6 and 8-18 in light of the combination of Peterson and Baker. This combination, as noted more fully below, must fail as Peterson is not available for a section 103(a) ground of rejection because section 103(c) bars its use.

As best as Applicant understands the Office Action, each ground of rejection is addressed below. Applicant, in light of these remarks, requests that all of the pending claims 1-18 be allowed.

Section 102(e) Rejection

The Examiner rejected claim 7 “under 35 U.S.C. 102(e) as being anticipated by Peterson et al. U.S. Patent No. 5,933,812.” As noted above, U.S. Patent No. 5,933,812 issued to Meyer et al. and not Peterson. In the paragraphs following the quoted statement, the Examiner cited page 12, paragraph 129 of Peterson as providing the teachings that anticipated claim 7. U.S. Publ. No. 2003/0170033, which was noted by the Examiner on the Notice of Cited References, names Peterson as the first applicant and does have a paragraph 129 on page 12 of the specification. Therefore, Applicant concludes that the Examiner is basing the section 102(e) ground of rejection on Peterson, U.S. Publ. No. 2003/0170033.

In rejecting claim 7, the Examiner contends that Peterson discloses an apparatus for bi-directional optical communication with a device external to the probe. Peterson is not directed to a probe, but rather to an optical I/O circuit that includes indicators that are visible on the control panel of an appliance. *Peterson*, paragraph 35. The optical I/O circuit is part of an appliance control circuit. *Peterson*, paragraph 82. As taught in Peterson, the optical receiver is an indicator light, which is a detector LED. *Peterson*, paragraph 120. The only variation for the optical communication devices in Peterson are those given in paragraph 152, which states the optical communication devices may be a segment of an alphanumeric display instead of a simple indicator light. Thus, there is no explicit teaching in Peterson that the optical receiver includes a sensitive phototransistor. In fact, the word “phototransistor” is not found in Peterson. Thus, Peterson does not disclose each and every limitation of claim 7 and, therefore, cannot anticipate claim 7, which requires the optical receiver to include a sensitive phototransistor.

Section 103 Rejection

In the Office Action, the Examiner rejected claims 1-6 and 8-18 as being obvious over the combination of Meyer et al. U.S. Patent No. 5,933,812 and Baker et al. U.S. Patent No. 7,019,492. In the details of the rejection presented on pages 3-5 of the Office Action, however, the Examiner does not refer to Meyer, but rather Peterson. The references to

Peterson appear to be consistent with U.S. Publ. No. 2003/0170033 as Peterson does discuss an optical transmitter 36, an optical receiver 37, and a FIG. 9 that is a schematic diagram of a bi-directional optical communication circuit. Therefore, Applicant has concluded that the Examiner has rejected claims 1-6 and 8-18 as being unpatentable over Peterson in view of Baker.

The combination of Peterson and Baker is not available to the Examiner because the subject matter of Peterson, which the Examiner has cited under 35 U.S.C. 102(e), was subject to an obligation of assignment to the owner of the present application, at the time the invention was made. This fact is apparent from a comparison of the assignee listed on the face of U.S. Patent No. 7,030,773, which issued from the application made public in U.S. Publ. No. 2003/0170033, with the assignee of the present application at Reel 014345, Frame 0966. Section 103(c) states that a reference subject to such an obligation shall not preclude patentability of an invention under section 103(a). Therefore, Applicant submits that the section 103 ground of rejection should be withdrawn.

Amendment
June 20, 2007

Conclusion

For the reasons set forth above, claim 7 is not anticipated by the Peterson reference and the Peterson reference may not be used in support of a section 103(a) ground of rejection. Therefore, the pending claims 1-18 are patentable over all references of record, either alone or in combination. Reexamination and allowance of all pending claims are earnestly solicited.

Respectfully submitted,
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